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EXAMINER

LIANG, REGINA

ART UNIT PAPER NUMBER

2674

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/903,193

Applicant(s)

HAUTANEN ET AL.

Examiner

Regina Liang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

2. Claims 1-4, 7-17, 50, 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg et al (US. PAY. NO. 6,084,583 hereinafter Gerszberg) in view of Asai et al (US. Pub. No. 2002/0000984 hereinafter Asai).

As to claims 1, 50, Gerszberg discloses an advertising screen saver comprising displaying content on a display (141 in Fig. 3A), detecting an indication of user inactivity, receiving an advertisement, and displaying the advertisement on the display (see Fig. 8 and col. 8, lines 30-54). Gerszberg does not disclose the display is a bistable display and the advertisement remains on the display after removing power to the display. However, Asai teaches an electronic device comprising a bistable display for displaying advertisement on the display. Asai also teaches the advertisement remains on the bistable display after removing power to the display (for example see page 2, lines 9-12 in section [0029], page 6, lines 1-4 in section [0121], page 11, lines 8-10 in section [0178]). Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the display of Gerszberg to have a bistable display and the advertisement remains on the bistable display after removing power to the display as taught by Asai so as to provide a display device terminal in which energy conservation can be achieved and a predetermined display such as an advertisement can be efficiently updated without the ease of use being deteriorated (page 1, section [0014]).

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As to claim 2, Asai teaches the display is a bistable reflective display.

As to claim 3, Gerszberg teaches receiving the content and detecting a predetermined period of user inactivity with respect to the content (col. 8, lines 30-42).

As to claim 4, Gerszberg teaches the content and advertisement are received via the Internet (col. 4, lines 35-40).

As to claims 7, 8, 11, Fig. 2 of Asai teaches the advertisement remains on the display for an extended period of time after power has been removed, and displaying a different advertisement on the display after a predetermined period of time.

As to claim 9, Fig. 8 Gerszberg teaches the advertisement replaces the content on the display during the screen saver mode.

As to claim 10, Fig. 2(c) of Asai also discloses the content remains on the display after power has been removed.

As to claims 12-17, Fig. 1 of Asai teaches transferring content or advertisement to a plurality of terminals from a host terminal having advertisement server or content server (e.g., page 6, sections [0114], [0120], and page 11, section [0186]).

As to claim 53, Gerszberg as modified by Asai teaches the advertisement remains on the display after power has been removed and power remains removed until user activity is detected (see Asai in sections [0121], [0201] for example).

3. Claims 18, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg and Asai as applied to claim 17 above, and further in view of Nanba et al (US. PUB. NO 2001/0006389 hereinafter Nanba).

Gerszberg as modified by Asai does not disclose transmitting information between other terminals via a low power radio frequency or bluetooth. However, Nanba teaches transmitting information between other terminals via a low power radio frequency or bluetooth (page 4, section [0066] and lines 4-5 in section [0072]). Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gerszberg as modified by Asai to transmit information between other terminals via a low power radio frequency or bluetooth as taught by Nanba for providing a wireless communication such that the operability of the receiving terminal devices is improved.

1. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg and Asai as applied to claim 1 above, and further in view Hyakudai et al (US. PAT. NO. 5,920,598 hereinafter Hyakudai).

Gerszberg as modified by Asai does not disclose the content and advertisement are received via a DVB-T receiver. However, it is well known in the art that a data transmission comprising a DVB-T (col. 1, lines 35-37 of Hyakudai). Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gerszberg as modified by Asai to transmit the content and advertisement via a DVB-T receiver so as to provide digital signal transmission by ground waves to broadcast the advertisements to the terminals.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg and Asai as applied to claim 1 above, and further in view of Munyan (US. PAT. NO. 5,761,485).

Gerszberg as modified by Asai does not disclose the content is a page of an electronic book and detecting a page turn at a particular time, and the period of user inactivity begins with the time of the page turn and ends a predetermined time later. Asai teaches the electronic device comprising an electronic book (page 15, lines 4-5 in section [0238]). Munyan teaches an electronic book with a page turn function (col. 8, lines 35-41). Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the content of Gerszberg as modified by Asai to be a page of an electronic book with a page turn function as taught by Munyan so as to provide a portable electronic device that stores and displays many publications within a single unit. In addition, Gerszberg teaches that an inactivity is detected in order to display the advertisement, thus in order to detect the inactivity of user in an electronic book device, it would have been further obvious to one of ordinary skill in the art at the time the invention was made to modify Gerszberg as modified by Asai and Munyan to detect a page turn at a particular time, and the period of user inactivity begins with the time of the page turn and ends a predetermined time later to determine user inactivity so as to provide a screen saver mode in the electronic book device.

5. Claims 20-24, 27-37, 41, 42, 46-49, 51, 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg and Asai as applied to claim 1 above, and further in view Strietzel (US. PUB. NO. 2002/0120564).

As to claims 20, 21, 51, Asai teaches the terminal is a mobile terminal (portable telephone as shown in Fig. 1). Gerszberg as modified by Asai would include a mobile terminal as claimed. Gerszberg as modified by Asai does not explicitly disclose receiving an advertisement

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at the time of downloading content. However, Strietzel teaches a terminal receiving an advertisement at the time of downloading content (i.e., see sections [0012], [0049]). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the terminal of Gerszberg as modified by Asai to receive an advertisement at the time of downloading content so as to provide targeted multimedia content and advertising.

As to claims 41, 52, Strietzel disclose storing advertisements linked to the stored content (see section [0012] for example).

As to claim 22, Asai teaches the display is a bistable reflective display.

As to claim 23, Gerszberg teaches receiving the content and detecting a predetermined period of user inactivity with respect to the content (col. 8, lines 30-42).

As to claims 24, 42, Gerszberg teaches the content and advertisement are received via the Internet (col. 4, lines 35-40).

As to claims 27, 28, 31, Fig. 2 of Asai teaches the advertisement remains on the display for an extended period of time after power has been removed, and displaying a different advertisement on the display after a predetermined period of time.

As to claim 29, Fig. 8 Gerszberg teaches the advertisement replaces the content on the display during the screen saver mode.

As to claim 30, Fig. 2(c) of Asai also discloses the content remains on the display after power has been removed.

As to claims 32-37, 46-49, Fig. 1 of Asai teaches transferring content or advertisement to a plurality of terminals from a host terminal having advertisement server or content server (e.g., page 6, sections [0114], [0120], and page 11, section [0186]).

6. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg, Asai and Strietzel as applied to claim 41 above, and further in view Masahiro et al (JP 10105144 hereinafter Masahiro)

As to claim 44, Gerszberg as modified by Asai and Strietzel does not disclose the advertisement is randomly selected from a plurality of advertisements. However, Masahiro teaches a screen saver display control having an advertisement as a display object wherein the advertisement is randomly selected from a plurality of advertisements (see the abstract). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gerszberg as modified by Asai and Strietzel to randomly select an advertisement from a plurality of advertisements since it enables it to collect valuable information, such as marketing information, reasonable, showing the always optimal information and drawing a user's interest.

7. Claims 38, 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg and Asai and Strietzel as applied to claim 37 above, and further in view of Nanba.

Gerszberg as modified by Asai and Strietzel does not disclose transmitting information between other terminals via a low power radio frequency or bluetooth. However, Nanba teaches transmitting information between other terminals via a low power radio frequency or bluetooth (page 4, section [0066] and lines 4-5 in section [0072]). Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gerszberg as modified by Asai and Strietzel to transmit information between other terminals via a low power radio

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frequency or bluetooth as taught by Nanba for providing a wireless communication such that the operability of the receiving terminal devices is improved.

8. Claims 25, 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg and Asai and Strietzel as applied to claims 20, 41 above, and further in view Hyakudai.

Gerszberg as modified by Asai and Strietzel does not disclose the content and advertisement are received via a DVB-T receiver. However, it is well known in the art that a data transmission comprising a DVB-T (col. 1, lines 35-37 of Hyakudai). Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gerszberg as modified by Asai and Strietzel to transmit the content and advertisement via a DVB-T receiver so as to provide digital signal transmission by ground waves to broadcast the advertisements to the terminals.

9. Claims 40, 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg and Asai as applied to claim 20, 41 above, and further in view of Hamzy.

Gerszberg as modified by Asai does not disclose the advertisement is a hyperlink on text. However, Fig. 6 of Hamzy an advertisement is a hyperlink on text. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gerszberg as modified by Asai to have the advertisement is a hyperlink on text as taught by Hamzy so as to increase the display time of advertisements associated with a particular URL.

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10. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg and Asai and Strietzel as applied to claim 20 above, and further in view of Munyan.

Gerszberg as modified by Asai and Strietzel does not disclose the content is a page of an electronic book and detecting a page turn at a particular time, and the period of user inactivity begins with the time of the page turn and ends a predetermined time later. Asai teaches the electronic device comprising an electronic book (page 15, lines 4-5 in section [0238]). Munyan teaches an electronic book with a page turn function (col. 8, lines 35-41). Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the content of Gerszberg as modified by Asai and Strietzel to be a page of an electronic book with a page turn function as taught by Munyan so as to provide a portable electronic device that stores and displays many publications within a single unit. In addition, Gerszberg teaches that an inactivity is detected in order to display the advertisement, thus in order to detect the inactivity of user in an electronic book device, it would have been further obvious to one of ordinary skill in the art at the time the invention was made to modify Gerszberg as modified by Asai, Strietzel and Munyan to detect a page turn at a particular time, and the period of user inactivity begins with the time of the page turn and ends a predetermined time later to determine user inactivity so as to provide a screen saver mode in the electronic book device.

Response to Arguments

11. Applicant's arguments with respect to claims 1-53 have been considered but are moot in view of the new ground(s) of rejection.

Applicants' remarks regarding the combination of Gerszberg and Asai on pages 12-13 are not persuasive. In response to applicants' argument "that there is no motivation to combine Gerszberg and Asai to arrive at the claimed invention. In particular, there is no motivation to modify Gerszberg to include the memory element display of Asai" and "Gerszberg is not interested in power conservation because the video telephone disclosed therein is not mobile, but instead is plugged into the customer premise's power supply", the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Asai teaches the terminal includes memory element display in which energy conservation can be achieved. Applicants' argue that Gerszberg is not interested in power conservation is conjecture and is incorrect. Even though Gerszberg's terminal (video telephone) is plugged into the power supply, it does not mean that Gerszberg is not interested in power conservation. As is well known all electronic devices are interested in power conservation since powered down mode during periods of non-use not only saves energy but also extends the life of the circuit components of the electronic device. Gerszberg teaches to activate a screen saver mode when an indication of user inactivity in order to protect the displays from damage due to burnout, which means that Gerszberg is interested in prolonging the life of the displays. Therefore, modifying Gerszberg's display device to comprise memory element display of Asai for conserving the power would also extends the life of the circuit components in Gerszberg's terminal would have been obvious to


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one of ordinary skill in the art at the time the invention was made. Furthermore, Asai teaches a telephone comprising a portable telephone. Thus, Gerszberg as modified by Asai would have a mobile terminal as claimed.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Regina Liang whose telephone number is (703) 305-4719. The examiner can normally be reached on Monday-Friday from 9AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe, can be reached on (703) 305-4709. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


REGINA LIANG
PRIMARY EXAMINER
ART UNIT 2674

RL
4/15/04